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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,489	03/08/2001	Isao Iwaguchi	1081.1111/JDH	2199
21171	7590	12/26/2007	EXAMINER	
STAAS & HALSEY LLP			KUCAB, JAMIE R	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
WASHINGTON, DC 20005			3621	
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			12/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/800,489	Applicant(s) IWAGUCHI ET AL.	
	Examiner Jamie Kucab	Art Unit 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22,23,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22,23,25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Acknowledgements**

1. This Office action is in response to the RCE filed on October 17, 2007.
2. The amendment filed October 17, 2007 is acknowledged.
3. This Office action is given Paper No. 20071217 for reference purposes only.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17, 2007 has been entered.
5. Claims 22, 23, 25, and 26 are currently pending.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 22, 23, 25, and 26 are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

9. Regarding claims 25 and 26, the limitations “and being held by a user” specifically limit the claims to the human body. A claim directed to or including within its scope a human being or attributes of a human being is not patentable subject matter. See MPEP §2105 and 1077 OG 24 (April 21, 1987). For purposes of Examination, the Examiner is interpreting this limitation as “adapted to being held by a user”.
10. Regarding claims 25 and 26, the claims are hybrid claims. See MPEP 2173.05(p) II. The claims recite method steps within a system claim. The claims are directed to neither a “process” nor a “machine,” but rather embrace or overlap these two different statutory classes of invention. The USPTO regards these claims as non-statutory subject matter. See ¶13 below for the Examiner’s interpretation of these claims.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
12. Claims 22, 23, 25, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. Regarding claims 22 and 23, the element “said processing device” lacks antecedent basis.
14. Regarding claims 25 and 26, these claims are hybrid claims and are, therefore, indefinite. See MPEP 2173.05(p) II. The claims recite method steps within a system

claim. The Applicant is claiming steps, such as, "calculating goods settlement information from said read goods information through said third communication unit", "processing the settlement in response to a prompt from a settlement key in accordance with authorization of said user", "said controller sends said goods settlement information to said mobile terminal", "the mobile terminal temporarily stores the goods purchase information in said memory" (claim 25), "calculating the goods settlement information from said read goods information", "processing the settlement", "said reader sends a send enable signal to said mobile terminal when said reader reads a barcode of said goods, receives a receive signal from said mobile terminal according to said send enable signal through said second communication unit, requests said goods purchase information to said register terminal in response to said received request, receives said goods purchase information from said register terminal through said third communication unit, and sends said received goods purchase information to said mobile terminal through said second communication unit", and "the mobile terminal temporarily stores the goods purchase information in a memory" (claim 26). As far as prior art rejections, the Examiner is looking at the structure of the claim, and not the steps recited in the system claim. Appropriate correction is required.

15. Regarding claim 25, the element "a controller" is introduced in both lines 3 and 10. For purposes of examination, the Examiner is interpreting these as separate elements along the lines of "a first controller" (line 3) and "a second controller" (line 10). Appropriate clarification or correction is required.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 22, 23, 25, and 26, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Swartz et al. (U.S. 2003/013298 A1 hereinafter "Swartz").

18. Regarding claims 25 and 26, Swartz discloses a goods purchase information processing system (Fig. 1-3, 6) in a store (site 10), comprising:

- a mobile terminal (portable terminals 12E or 12F in Fig. 1, 70 in Fig. 3) having
  - a first communication unit (radio 702),
  - a controller (CPU 701) and
  - a memory (memory 712) and
  - being held by a user (the portable terminals can be PDAs, ¶47);
- a reader (kiosk 19, scanning companion 21B, or terminal 21A) reading goods information for goods purchased by said user of said mobile terminal; and
- a register terminal comprises:

- a second communication unit (access point 13B) for communicating with said mobile terminal;
- a third communication unit for communicating with said reader (access point 13A); and
- a controller (central host 14) connected to said second and third communication units and calculating goods settlement information from said read goods information through said third communication unit and processing the settlement in response to a prompt from a settlement key in accordance with authorization of said user, wherein said controller sends said goods settlement information to said mobile terminal in response to a prompt from the settlement key of said goods settlement information through said second communication unit, and the mobile terminal temporarily stores the goods purchase information in said memory (¶242).

19. Regarding claim 22 and 23, Swartz further discloses wherein said mobile terminal transfers the goods purchase information (bookmark concerning an item of interest or customer's prior purchase records) from the memory into a household budget system (shopping list system) of said processing device (home computer 45) of said user (¶62, ¶64, ¶175, ¶212).

***Examiner Note***

20. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider the reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

***Claim Interpretation***

21. Independent claims (claims 25 and 26) are examined together, since they are not patentably distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in this application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

22. Unless expressly noted otherwise, the Examiner maintains the claim interpretations and definitions put forth in the previous Office actions, especially ¶s 8 and 9 of the Office action, Paper No. 20070503, mailed May 21, 2007.

***Response to Arguments***

23. Applicant's arguments with respect to the 103 rejections of claims 22, 23, 25, and 26 have been considered but are moot in view of the new grounds of rejection.



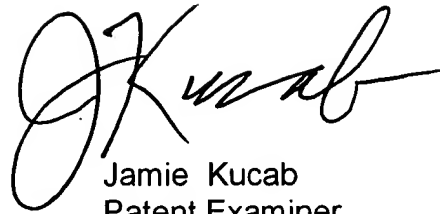
***Conclusion***

24. References considered pertinent to Applicant(s)' disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.


25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 12/17/07

Jamie Kucab  
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